UNITED STATES PATENT AND TRADEMARK OFFICE

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10/528,284	08/29/2005	Walter Keller	0740-70	6605

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *9-28* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *9-28* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some *   c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date *11/18/2005, 12/08/2005*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

Detailed Action

This Office Action is response to the application (10/528284) filed on 29 August 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

<u>Claims 9-20, 25-28</u> are rejected under 35 U.S.C. 103(a) as being unpatentable over

Fleming. US Patent No. **6,249,805** in view of **Sundsted** U.S. Patent No. **US 5,999,967.**

Regarding claim 9, Fleming teaches wherein a method to automatically handle

undesired electronic mail (e-mail) in communication networks at the receiver, the

method comprising:

automatically comparing the sender address accompanying an incoming e-mail

to an electronically accessed list of authorized sender addresses assigned to the

receiver **(Fig. 1, unit 106 – authorization component)**; and then

storing the e-mail in a mailbox MB of the recipient **(Fig. 2, unit 205 – store**

selected Email in inbox folder), wherein the only e-mails transferred to the receiver's

mailbox are those that had clearly been sent by authorized senders **(Fig. 2, unit 204 –**

retrieved ID in authorized list).

With respect to claim 9, Fleming teaches the invention set forth above except for

the claimed "*in combination with:*

performing an analysis to see if there is serial, incremental user identification

occurring so that conclusions can be drawn concerning automatic attempts at breaking

into the e-mail system."

Sundsted teaches that is well known to utilize filtering the receiving emails in

combination with performing an analysis to see if there is serial, incremental user

identification occurring so that conclusions can be drawn concerning automatic attempts

at breaking into the e-mail system **(Fig. 3A, unit 23 – Analysis Module; Fig. 4, unit 40**

- serial field).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Fleming's invention by adding analyzing module which

reads the serial number from Serial Number Field. It then checks History Log to see if

this electronic stamp has been received before. If the electronic stamp is found in

History Log, this is a good indication that the electronic mail has been delivered multiple

times, either due to a fault in the electronic mail system or due to malicious intent. In

either case, the electronic stamp and the associated electronic mail should be rejected.

Sundsted further discloses a Serial Number Field 40 which holds the serial number of

the electronic stamp. This number is issued by the sending system. A serial number

must never be reissued. The simplest serial number generator is a counter that is

incremented for each electronic stamp generated (Fig. 4, unit 40), as taught by

Sundsted.

Regarding claim 10, Fleming and Sundsted together taught the method according as in claim 9 above. Fleming further teaches wherein there are two logically or physically, or both, separate mailboxes, said mailbox MB **(inbox folder)** and a junk mailbox JMB **(Junk Mail folder)**, wherein the e-mail server sends to the JMB mailbox all incoming e-mails that indeed have the subscriber's correct recipient address but are not contained in the sender list on the receiving side **(If the retrieved ID does not match, than the authorization component stores the intercepted electronic mail message in a pre-designated location, such as a Junk Mail folder – Col. 4, lines 24-27)**, thus making them available for further processing selectively by the internet service provider, the administrative authorities, and by the recipient **(periodically, the user can view the Junk mail folder to delete or read (means further processing) the electronic messages that we designed as junk – Col. 4, lines 34-36)**.

Regarding claims 11 and 12, Fleming and Sundsted together taught the method according as in claim 9 above. Fleming further teaches wherein the incoming e-mails are selectively put through an automatic handling and analysis process **(The authorization component intercepts electronic mail messages that are sent to a user before they are placed in the user's Inbox folder—Col. 4, lines 15-17)**, which can be selectively configured by the recipient and by the ISP **(forwards the electronic mail message to the recipient via a communications mechanism such as a local area network or the Internet – Col. 1, lines 18-20)**, selectively in the e-mail server, in a comparison device **(various computer systems – Col. 1, lines 35)**, and in at least

one of the mailboxes **(Inbox folder or Junk Mail folder)**, said process initiated and

configured either on a case-by-case basis or permanently **(Fig. 3)**.

Sundsted further teaches wherein the incoming e-mails are selectively put

through an automatic handling and analysis process, which can be selectively

configured by the recipient and by the ISP, selectively in the e-mail server, in a

comparison device, and in at least one of the mailboxes, said process initiated and

configured either on a case-by-case basis or permanently **(Procmail – Col. 1, lines 30-**

41).

Regarding claims 13-16, Fleming and Sundsted together taught the method according

as in claim 9 above. Fleming further teaches wherein all executable programs sent as

attachments to e-mails are automatically separated in the JMB **(a user can indicate**

that all email messages received from a certain sender can automatically be

stored in a designed folder (e. i.; Junk Mail folder), ... Col. 3, lines 26-28).

Regarding claims 17- 20, Fleming and Sundsted together taught the method according

as in claim 9 above. Fleming further teaches wherein if an undesired e-mail is received,

discontinuation requests, or cease and desist demands, can be generated automatically

and delivered to the sender **(Whenever a recipient does not want to be included on**

a mailing list, the recipient can notify the de-spamming computer system, which

will add the recipient's electronic mail address to the list of electronic mail

addresses that are not to receive junk mail – Col. 3, lines 17-21).

Regarding claims 25-28, Fleming and Sundsted together taught the method according

as in claim 9 above. Fleming further teaches wherein the contents of the JMB can be

cyclically deleted at specific time intervals **(Periodically, the user can view the Junk**

Mail folder to delete or read the electronic mail messages that were designated as

junk – Col. 4, lines 33-36).

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Fleming. US Patent No. **6,249,805** in view of **Sundsted** U.S. Patent No. **US 5,999,967**

further in view of **Lalonde** US Patent No. **US 7,072,944**.

Regarding claims 21-24, Fleming and Sundsted together taught the method according

as in claim 9 above. However Fleming and Sundsted are silent in terms of "*wherein*

virus checks of the e-mail can be carried out selectively at an established time of day or

each time a message arrives."

Lalonde teaches that it is well known to have "wherein virus checks of the e-mail

can be carried out selectively at an established time of day or each time a message

arrives" **(Fig. 9, unit 174 – virus check)**.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Fleming's and Sundsted's invention by utilizing virus

system in which it solves the major problems of ensuring that the emails are handled in

an efficient and timely manner in the email engine. The application is typically provided

on a client machine (e.g. PCs) and communicates with a mail server so that, when the

client machine receives email from the mail server, the client plug-in authenticates the

email as described herein. Thus, each time the virus protection application checks an

email for a virus, it also authenticates the email to obtain an authentication indicator

which informs a user of the likelihood of the email being spoofed (as taught by Lalonde).

Response to Arguments

Applicant's arguments filed on 07/22/2008 have been fully considered but they

are not persuasive for the following reasons:

Applicant Argument:
Applicant respectfully disagrees.

The various analyses performed by the analysis module 23 of Sundsted are unrelated

to seeing if serial, incremental user identification is occurring

Examiner Response:
It is the claims that define the claimed invention, and it is claims, not specifications that

are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.,* 7 USPQ2d

1064.

Fleming discloses a method and system for filtering electronic mail messages that are

received from unauthorized senders. In one embodiment of the present invention, an

authorization component is included with an electronic mail system. The authorization

component intercepts electronic mail messages that are sent to a user before they are

placed in the user's Inbox folder. The authorization component has the identifications of

all senders who are authorized to send electronic mail messages to the user. When an

electronic mail message is intercepted, the authorization component retrieves the

identification of the sender from the envelope portion of the intercepted electronic mail

message. The authorization component then determines whether the retrieved

identification of the sender matches the identification of one of the authorized senders. If

the retrieve identification does not match, then the authorization component stores the

intercepted electronic mail message in a pre-designated location, such as a "Junk Mail"

folder (Col. 4, lines 11-36). Sundsted further discloses in Fig. 3A a diagram of the

receiver side of the filtering apparatus wherein An Analysis Module 23 connected to

Decryption Module 22. Analysis Module 23 validates the electronic stamp. It also

decides whether to accept, reject, or otherwise handle electronic mail based on the

value of its electronic stamp. Analysis Module 23 reads the serial number from Serial

Number Field 40. It then checks History Log 25 to see if this electronic stamp has been

received before. If the electronic stamp is found in History Log 25, this is a good

indication that the electronic mail has been delivered multiple times, either due to a fault

in the electronic mail system or due to malicious intent. In either case, the electronic

stamp and the associated electronic mail should be rejected (Col. 8, lines 27-24).

Sundsted further discloses a Serial Number Field 40 which holds the serial number of

the electronic stamp. This number is issued by the sending system. A serial number

must never be reissued. The simplest serial number generator is a counter that is

incremented for each electronic stamp generated (Fig. 4, unit 40).

Also, the analysis is a statement of intended use and the specification dose not explicitly state what a "serial, incremental user ID occurring". Therefore, examiner maintains the rejection.

Conclusion

Applicant's arguments filed on 07/22/2008 have been fully considered but they are not persuasive for the following reasons **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SULAIMAN NOORISTANY whose telephone number is (571)270-1929. The examiner can normally be reached on Monday Through Friday 9:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Pwu can be reached on 571-272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sulaiman Nooristany whose telephone number is (571) 270-1929. The examiner can normally be reached on M-F from 9 to 5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu, can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR: Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system,

see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

Sulaiman Nooristany 08/21/2008

/Joseph E. Avellino/

Primary Examiner, Art Unit 2146